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10/618,573

07/11/2003

Babu J. Mavunkel

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25225 7590 02/05/2007  
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12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

EXAMINER

DESAI, RITA J

ART UNIT

PAPER NUMBER

1625

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|-----------|---------------|
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3 MONTHS

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/618,573 | <b>Applicant(s)</b><br>MAVUNKEL ET AL. |  |
|                              | <b>Examiner</b><br>Rita J. Desai     | <b>Art Unit</b><br>1625                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/6/05 and 11/13/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1,5-10 are pending.

Claims 1, 5-7 are drawn to compounds and claims 8-10 are drawn to a method of amination using these compounds.

The arguments presented again on the rejection of claims 8-10 under 35 USC 112 first and second paragraph has been considered and found to be persuasive. The claims are drawn to a method of using the reagent as an animating agent and would depend on the compound which is being animated. Thus the rejection has been withdrawn.

The rejection of claims 1-7 under 35 USC 103 over US 4472194 or Tesseir et al US 4801,717 has been withdrawn also as applicants arguments have been found to be convincing. The reference teaches a genus but not the specific species. The compounds 1, 5-7 require that n is 1-3.

The new rejection of claims 1, 5-7 under 35 USC 112 alleging the written description has been withdrawn as applicants do have in their original claims the term n being 1-3.

However there are new grounds of rejection

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Caplus English abstract DN 107:197769 Ishida Tatsukazu et al.

The reference discloses a process of using the compounds as aminating agents.

See the abstract of JP 62070344 1987. The compound RN 42865-91-8P reads on the compounds of the invention where in n is 0 and A1 and A2, one is a nitro and the other is a CF3.

The reference clearly uses the compound for amination of other compounds in the presence of a base and a solvent and also the compound II is an compound that comprises an indole, meeting the limitations of claims 9 and 10.

### ***Claim Rejections - 35 USC § 103***

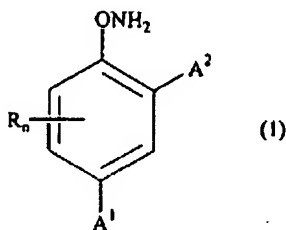
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caplus English abstract DN 107:197769 Ishida Tatsukazu et al.

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Applicants claims are drawn to compound of the formula I ,



wherein one of A1 and A2 is a NO2 and the other is CF3., n is 1-3 and R is a CF3 or a halogen or an alkyl.

*Determination of the scope and content of the prior art (MPEP §2141.01)*

The reference teaches a small genus of the formula I as given in the abstract where n is 1-3, X is 5-n and X is halogen alkyl haloalkyl; Thus a teaching of the various substitutions is given.

*Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*

The specific species wherein the R(n) is atleast 1 is not shown .

However 1) a very small genus is taught and 2) applicants have not made and exemplified any compounds with n being atleast 1 and uptill 3.

*Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)*

In view of the guidance given by the applicants and also in view of the small genus taught by the reference , one of skill in the art would be motivated to make the compounds as described in claim 1, 5-7.

The use of the compounds is also the same as that of the prior art, provided added motivation for one skill in the art to make the compounds of the inventions.

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***Conclusion***

Claims 1, 5-10 stand rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Rita J. Desai  
Primary Examiner  
Art Unit 1625

*RJ Desai*  
1/25/07

R.D.  
January 25, 2007